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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,106	06/01/2001	Ellis L. Reinherz	1062.1021-004	2390

21005 7590 10/01/2002

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EXAMINER

DECLoux, AMY M

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 10/01/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,106

Applicant(s)

REINHERZ ET AL.

Examiner

Amy M. DeCloux

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 and 47-49, drawn to an isolated CD2BP2 protein, classified in class 530, subclass 350.
- II. Claims 7-22, and 44-46 drawn to a nucleic acid which encodes a CD2BP2 protein, classified in class 536, subclass 23.1.
- III. Claims 23-24, drawn to an antibody which selectively binds to isolated CD2BP2 protein, classified in class 530, subclass 387.1.
- IV. Claims 25-26, drawn to a method of assaying the presence of CD2BP2 comprising an antibody, classified in class 435, subclass 7.1.
- V. Claims 27-29, drawn to an assay for identifying an agent which inhibits activity of CD2BP2 protein, said agent, and a method which inhibits activity of the CD2BP2 protein, classified in class 435, subclass 7.1.
- VI. Claims 30-32, drawn to an assay for identifying an agent which enhances activity of CD2BP2 protein, classified in class 435, subclass 7.1.
- VII. Claims 33-34, drawn to a method of identifying an agent which modulates signal transduction or cell adhesion, classified in class 435, subclass 7.1.
- VIII. Claims 35-38, drawn to an assay for identifying an agent which enhances CD2-triggered IL-2 production, said agent, and a method of enhancing CD2-triggered IL-2 production, classified in class 435, subclass 7.1.
- IX. Claims 39-42, drawn to an assay for identifying an agent which inhibits CD2-triggered IL-2 production, said agent, and a method of inhibiting CD2-triggered IL-2 production, classified in class 435, subclass 7.1.
- X. Claims 50-51, drawn to a method of enhancing protein-protein interactions comprising a nucleic acid, classified in class 435, subclass 6.
- XI. Claims 52-53, drawn to a method of enhancing protein-protein interactions comprising a protein, classified in class 435, subclass 7.8.

The inventions are distinct, each from the other because of the following reasons:

Groups I/II/III are unique products. They differ with respect to their structure, amino acid, nucleic acid and antibody, respectively, and consequently have distinct biochemical properties conferred by said structure. Therefore Groups I/II/III are patentably distinct.

Groups IV-XI are unique methods. They differ with respect to their respective process steps and endpoints. Therefore, they are patentably distinct, each from the other.

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1. Groups III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the antibody, can be used in a method for immunopurification of CD2BP2, as well as in a method of assaying the presence of CD2BP2.
2. Groups II and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the nucleic acid, can be used in a method for determining the expression level of CD2BP2, as well as in a method of enhancing protein-protein interactions.
3. Groups I and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the protein, can be used as an immunogen in a method for producing antibody secreting hybridomas, as well as in a method of enhancing protein-protein interactions.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and because a search in the non-patent literature of any of these distinct inventions would not be co-extensive with a search of the others, an examination and search of two or more inventions in a single application would constitute a serious undue burden on the Examiner, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is 703 306-5821. The examiner can normally be reached on M-F 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 703 308-3973. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-3014 for regular communications and 703 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0196.

Amy DeCloux, Ph.D.,
Patent Examiner
September 30, 2002


Patrick J. Nolan, Ph.D.
Primary Patent Examiner,
Group 1640